

## **COMMENTS**

### **The Office Action**

Claims 1-6, 8-18 and 20-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 6,738,155 to Rosenlund in view of U.S. Publication No. 2001/0002204.

Claim 1 has been amended to include new limitations.

Claims 8 and 9 have been canceled.

Claims 22 and 23 have been added.

### **No Motivation to Combine the Cited References**

In the April 6, 2006 Office Action, it was agreed that Rosenlund does not disclose prescanning the publication data for verifying the potential pathname. It was proposed, however, that combining Jebens et al, which teaches prescanning, with Rosenlund, would have been obvious to a person of ordinary skill in the art at the time of the invention. Applicant respectfully traverses this position, and submits that Rosenlund's invention inherently has no need for any prescanning system.

The HSM system taught in Rosenlund contains a table of known locations of files (i.e. the HFD – see col. 14, lines 37-40). This system already knows that the file pathname is correct and therefore has no need to prescan a potential pathname to verify that it is correct. As such, there is no motivation to combine any prescanning system with the invention in Rosenlund.

### **The Claims are Patentably Distinguished Over the Cited References**

The April 6, 2006 Office Action asserts that Rosenlund teaches some limitations of claim 1, namely finding a comment within the data stream and determining a location of the image, stored using a second system different from the first, as a function of the comment. Column 13 lines 18-26 in Rosenlund are first cited as a reference to a process which finds imbedded comments, specifically imbedded OPI comments, and column 14 lines 33-50 are cited as a reference to a second system which determines the location of the image as a

function of the comment. However, as Attachment A indicates, OPI comments are Open Prepress Interface (OPI) comments which are a collection of PostScript language comment conventions that enable a page-layout program for layout and proofing. It is not described as being used to determine high resolution data, a path name or location of the high resolution data. Moreover, column 14 lines 33-50 do not make any reference to using the imbedded comments to determine the image location, but instead describe a second system which references "a plurality of tables that correlate each file's name, path [and] location on a particular storage device." As such, Rosenlund does not teach the limitation of determining a location of the image, stored using a second system different from the first, as a function of the comment.

Next, the Office Action asserts that Rosenlund teaches comparing a comment within the publication data to search paths and path mappings in order to identify a potential pathname, as set forth in claim 10. Specifically, column 16 lines 50-58 and column 14 lines 33-41 in Rosenlund are cited. These references describe a system in which metadata, or data about the publication data, is stored in a database, separate from the publication data. This database contains "a plurality of tables that correlate each file's name, path [and] location," (see column 14 lines 37-39.) More importantly, this database **1014** is part of an HSM server **122** which is separate from the publication data or end user facility **300**, (see FIG 3 and FIG 10)

By contrast, the method in claim 10 seeks to identify the desired file location by comparing a comment, imbedded in the publication data, to path mappings and search paths in order to determine a potential pathname. A difference between the two systems is that the method in claim 10 determines the pathname by processing a comment imbedded within the publication data, while the Rosenlund system retrieves the pathname from a remote database.

Similarly, claim 16 includes a limitation whereby the pathname of the desired file is determined as a function of the imbedded comment. As Rosenlund uses a distinctly different system which does not determine the pathname as the function of a comment, but retrieves the pathname from a remote database, claim 16 is also patentably distinguished over Rosenlund.

Thus, applicant respectfully contends that Rosenlund does not teach the use of imbedded comments for determining an image location as described in claims 1, 10 and 16.

Also asserted is that Jebens et al teaches the same prescanning limitation of claims 1, 10 and 16. The search described in Jebens is an option, selected from a browser menu, whereby a user manually enters search parameters into the browser and searches "user specified fields in the item records" for the desired data file, (see paragraph 59.) When the search results are compiled, the user may then select "any or all of the data files identified in the search for downloading," (see paragraph 63.)

Unlike Jebens, the prescanning described in claims 1, 10 and 16 does not require or even allow the user to manually enter search parameters to search specified fields, but instead prescans the publication data for an imbedded comment, and then verifies that pathname found within that comment is correct. By contrast, Jebens does not verify a pathname, but instead requires the user to manually enter search parameters, then returns any number of data files matching those parameters, and allows the user to download any number of the returned files.

Accordingly, applicant respectfully contends that Jebens does not teach the prescanning limitation of claims 1, 10 and 16.

### **Amendments to Claim 1**

Claim 1 has first been amended to include the manual path entry limitation formerly of claim 8, and the gathering limitation formerly of claim 9.

Next, the limitations of retrieving the image, inserting it into the publication data, and outputting the publication data to an output device, similar to claim 10, have also been added to claim 1.

The phrase "data stream" has also been changed to "publication data" to more specifically indicate that the imbedded comment, and therefore the reference to the image location, exists within the incoming publication data.

Lastly, the phrase “automatically initiating a scan, by the print controller, of the incoming data to search for references to image files which may not be locally accessible, and verifying that those references are correct” has been added to further describe the prescanning step, and to emphasize the point that the prescan is executed on the fly by the print controller, without requiring or allowing any manual search from the user. This limitation is distinct from the prescanning taught by Jebens et al, which uses manually entered search parameters to search for the desired file, and returns all files matching the search, allowing the user to download any number of returned files.

### **New Claims**

Claims 23 and 24, depending from claims 10 and 16 respectively, have been added to include the same prescanning limitation as claim 1.

**CONCLUSION**

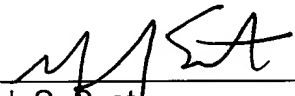
For the reasons detailed above, it is submitted all claims remaining in the application (Claims 1-6, 10-18, and 20-24) are now in condition for allowance. The foregoing comments do not require unnecessary additional search or examination.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby authorized to call Mark S. Svat, at Telephone Number (216) 861-5582.


Respectfully submitted,

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Date

  
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Enclosure: Attachment A

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